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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/815,614

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Paul Lapstun

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EXAMINER

ZHANG, FAN

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

08/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/815,614

Applicant(s)

LAPSTUN ET AL.

Examiner

FAN ZHANG

Art Unit

2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Applicant's amendment is not entered for the fact that reconsideration on obviousness of combining Kurokawa and Kirkham for the rejection of claims 3, 8, 17, 32, and 34, Kurokawa and Saito for the rejection of claims 11 and 29, and Kurokawa and Endoh for the rejection of claims 20 and 41 as new issues requiring further consideration and/or search.
(See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4, 8, 11, 14, 15, 17, 20, 27-29, 32-36, 41, and 47.

Claim(s) withdrawn from consideration: 5-7, 9, 10, 12, 13, 16, 18, 19, 21-26, 30, 31, 37-40, 42-46 and 48.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Mark K Zimmerman/
Supervisory Patent Examiner, Art Unit 2625

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments received on July 29, 2008 with respect to amended independent claims 1 and 27, which are the original claims 15 and 36 have been fully considered but they are not persuasive.

Applicant's amendment is not entered for the fact that reconsideration on obviousness of combining Kurokawa and Kirkham for the rejection of claims 3, 8, 17, 32, and 34, Kurokawa and Saito for the rejection of claims 11 and 29, and Kurokawa and Endoh for the rejection of claims 20 and 41 as new issues requiring further consideration and/or search.

With respect to Lubow's teaching, Applicant argues that barcode data on a product, such as a commodity number or batch number, is allocated for each product rather than product item which is different for each instance of the product. As explained in the final rejection, the claim fails to specify the relative relationship and location between two product items that are distinguished from each other. In other words, Examiner interprets the claim language as one product item in batch #1 has product identity data different from that of an item in batch #2. Applicant further argues that "Lubow fails to teach multiple coded data portions identifying the product items". Examiner respectfully disagrees. As stated in [p0017], Lubow teaches: "the first, and second information are analyzed to see if they are consistent. For example, the first bar code indicia may designate a product identifier such as a specific drug, while the second bar code indicia identifies a commodity number, in which case the information is analyzed to determine if the commodity number is known to be associated with the particular drug..." Obviously, information from both bar codes is related to the identification of a particular product. If the first and second information has to be consistent as stated above, how could one part be indicative of a product identity whereas the other part is not?

With respect to Kurokawa's teaching on multiple bar codes being indicative of the respective position of the coded data portions on the interface surface, Applicant argues that it's not obvious to combine the teachings from Kurokawa and Lubow since Kurokawa does not relate to printing an interface surface associated with a product item. Again, Examiner respectfully disagrees. First of all, multiple bar codes are used in both Kurokawa and Lubow's teaching for serving the same purpose: information indication. Just because different information is encoded in a bar code or a bar code is applied to different applications does not render one bar code to be structurally unique from another bar code, nor does it render printing one bar code to be methodically different from printing another one. Second, the data of coded data portion in the amended claim, "indicative of the respective position of the coded data portions on the interface surface", does not relate to product item or product identification either. They merely indicate the respective position of the coded data. Further, since Lubow applies different printers to print multiple bar codes that carry related information of a product on product surface in stack or non-stack format, it would be crucial to be aware of the relative position of each bar code from one another in order to avoid overlapping or faulty positioning of labeling. Therefore, given Kurokawa's teaching on the relative position of each bar code, the combination of the teaching would have been obvious to an ordinary skilled in the art. Applicant continues to argue that "the bar codes of Kurokawa do not encode a position on the surface". Examiner further disagrees. Kurokawa teaches: "Each of the 64 bar codes contains address data indicating a relative position of the bar code within the 64 segment" [col 13: lines 35-37]. As illustrated in fig. 17, all 64 segments are on the same surface. It is obvious that the position of each bar code is relative to other 63 bar codes on the same surface.

With respect to the information disclosure statement (IDS) received on July 29, 2008, the submission which is filed after the final rejection is not in compliance with the provisions of 37 CFR 1.97 since it lacks of a statement as specified in 37 CFR 1.97(e) that must state either

(1) that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement or

(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.

Accordingly, the information disclosure statement is not being considered by the examiner.